

REMARKS

I. Introduction

Claims 1 – 16 are presently pending, and are rejected. Following entry of the present amendment, claims 1, 3, 4, 5, 7, 8, 9, and 14 are amended, new claims 17 - 21 are presented, and claims 2, 15, and 16 are canceled.

Support for the amendment to claims 3, 4, 8 and 9 may be found in the table of page 11. Support for the amendment to claim 7, and new claims 17 and 18 may be found at page 3 line 34 – page 4 line 19. Support for new claims 19 and 20 may be found at page 5, lines 9 – 11. Support for new claim 21 may be found at page 13, lines 18 – 19. It is believed no new matter has been added.

Applicants acknowledge, and are grateful to the Examiner for withdrawing the restriction requirement.

Claims 3, 5, 8 and 16 are objected to for informalities. Applicants thank the Examiner for identifying these typographical errors, and have amended claims 3, 5 and 8 accordingly, and have canceled claim 16.

II. Rejections under 35 USC § 112

A. Claims 14 – 16 are rejected under 35 USC 112 second paragraph because the claims do not set forth any steps involved in a method/process. In response, Applicants have amended claim 14 and canceled claims 15 and 16, and request the rejection be withdrawn.

B. Claims 14 – 16 are rejected under 35 USC 101 because the claimed recitation of a use results in an improper definition of a process. In response, Applicants have amended claim 14 and canceled claims 15 and 16, and request the rejection be withdrawn.

C. Claims 3 and 8 are rejected under 35 USC 112, second paragraph, as failing to set forth the subject matter which Applicants regard as their invention. Specifically, the amount of concentrate capable of being solubilized is not given. In response, Applicants have amended claims 3 and 8, and request the rejection be withdrawn. Support for the amendment may be found in the table of page 11.

D. Claims 4 and 9 are rejected under 35 USC 112, second paragraph, as failing to set forth the subject matter which Applicants regard as their invention because there are no units

given for the density range claimed. In response, Applicants have added units, and request the rejection be withdrawn. Support for the amendment may be found in the table of page 11.

III. Rejections under 35 USC § 103(a)

A. Claims 1 and 15 are rejected under 35 USC 103(a) as being unpatentable over Tansley et al. (EP 0449553). Applicants respectfully traverse the rejection, however have amended claim 1 to incorporate the limitations of claims 12 and 7, and canceled claim 15 in order to advance prosecution, and request the rejection be withdrawn.

B. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over Tansley et al. in view of Halliday (US 2003/0033938). Applicants have canceled claim 16, and request the rejection be withdrawn.

C. Claims 2, 3, 4 and 6 are rejected under 35 USC 103(a) as being unpatentable over Tansley et al. in view of Fox (US 2,977,231) and Durrenmatt et al. (US 2,380,158). The Examiner find Tinsley et al. discloses the process of claim 1, but fails to disclose the composition of the beverage concentrate. However the Examiner finds Fox discloses a beverage concentrate for producing a chocolate beverage comprising cocoa powder, and thus it would have been obvious to one of skill in the art to combine the process of Tinsley with the use of a cocoa powder containing beverage concentrate like the one disclosed by Fox because such a concentrate contains a higher cocoa content than conventional syrups and is capable of easily dissolving in liquid. However, Tansley et al. and Fox et al. fail to disclose incorporating a cocoa taste enhancer into the concentrate, but the Examiner finds Durrenmatt discloses a water soluble cocoa extract which can be incorporated into foods and ice cream mixes, and thus it would have been obvious to combine the process of Tinsley and Fox with the addition of a cocoa taste enhancer as disclosed by Durrenmatt.

Applicants respectfully traverse this rejection, as a prima facie case of obviousness has not been established over the claims, and request that the rejection be withdrawn.

The obviousness determination requires four kinds of factual inquiries:

- (1) the scope and contents of the prior art;
- (2) the differences between the prior art and the claims at issue;

- (3) the level of ordinary skill in the pertinent art; and
- (4) any objective indicia of success such as commercial success, long felt need, and copying.

KSR Int'l., Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1735 (2007) (citing *Graham v. John Deere Co.*, 383 US 1, 17-18 (1966)). The Supreme Court in *KSR* recognized that a showing of "teaching, suggestion, or motivation" to combine prior art could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 USC 103(a). *Id.* at 1741. The Supreme Court specifically stated that "it will be necessary . . . to determine whether there was an apparent reason to combine [or modify] the known elements [in the prior art] in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made *explicit*." *Id.* at 1740 - 41 (emphasis added).

1. The scope and content of the Prior Art and Differences Between the Prior Art and Claimed Invention:

Claim 1, from which claims 3, 4 and 6 depend from is directed to a process for producing a chocolate drink containing at least 2% of cocoa. A capsule is inserted into a coffee machine operating by percolation under pressure of a dose of coffee, water is injected in order to solubilize the concentrate contained within the capsule, and the chocolate drink is recovered.

Fox et al discloses various drink concentrates which are packaged in pressurized containers. Fox et al fails to teach or suggest

Durrenmatt et al. discloses methods and compositions relating to treating roasted and shelled cocoa beans. Water is forced through coarsely broken cocoa nibs, and is recovered, and may be concentrated. The aqueous extract may be combined with ice cream mixes, foods, and milk.

Tansley discloses sealed packages containing comestibles (including powdered chocolate) and a process for producing drinks containing such comestibles.

2. The obviousness determination

Applicants submit the present rejection is based on mere identification of individual components in the prior art, and mere identification in the prior art of each component does not show that the combination as a whole lacks the necessary attributes for patentability, i.e., is obvious. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). To establish a prima facie case of

obviousness based on a combination of elements in the prior art, the law requires a motivation to select the references and to combine them in the particular claimed manner to reach the claimed invention. *Eli Lilly and Co. v. Zenith Goldline Pharma., Inc.*, 471 F.3d 1369 (Fed. Cir. 2006).

Fox et al. is relied upon for a beverage concentrate for producing a chocolate beverage comprising cocoa powder. Applicants submit one of skill in the art would not look to Fox et al. in providing a chocolate syrup containing cocoa because the disclosure as a whole lacks any teaching, suggestion, or motivation to combine the reference with the process described in Tansley et al. Fox et al. discloses chocolate syrups are packaged in pressurized containers. One of skill in the art would not seek to use pressurized containers in the process described in Tansley et al., as use of such pressurized containers would lead to disastrous consequences, e.g., explosions. Moreover, there is no teaching in Tansley et al. to specifically incorporate the compositions of Fox et al., nor is there any teaching of Fox et al. to use the compositions in the processes of Tansley et al.

Durrenmatt fails to cure the deficiencies of Fox et al. and Tansley et al. Durrenmatt merely discloses an aqueous extract of cocoa nibs, and fails to teach or suggest any benefit of adding cocoa powder, much less producing a chocolate drink with a coffee machine which operates by percolation under pressure.

D. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Tansley et al in view of Fox and Durrenmatt et al., and further in view of Smith (US 3,385,714). Applicants respectfully submit the combination of Tansley et al., Fox et al., and Durrenmatt et al. do not teach or suggest all of the limitations from the claims it depends from, and Smith fails to cure such a deficiency. Accordingly, Applicants request the rejection be withdrawn.

E. Claims 7 – 9 and 11 are rejected under 35 USC 103(a) as being unpatentable over Fox in view of Durrenmatt.

The Examiner finds Fox discloses a beverage concentrate containing cocoa powder, but fails to disclose the addition of a cocoa taste enhancer. However, the Examiner finds Durrenmatt discloses a water soluble cocoa extract which can be incorporated into foods and ice cream mixes, and thus it would have been obvious to combine the product of Fox with the cocoa taste enhancer of Durrenmatt because such a taste enhancer incorporates highly soluble and sediment free flavor containing all cocoa flavorings except for fat.

Applicants respectfully traverse the rejection, and request it be withdrawn. The present rejection is simply based on the identification of individual components in the prior art, and there is no teaching, suggestion, or motivation to combine the references.

F. Claim 10 is rejected under 35 USC 103(a) as being unpatentable over Fox et al. in view of Durrenmatt et al., and further in view of Smith.

Applicants respectfully traverse the rejection, and request it be withdrawn. The present rejection is simply based on the identification of individual components in the prior art, and there is no teaching, suggestion, or motivation to combine the references.

G. Claims 12 and 13 are rejected under 25 USC 103(a) as being unpatentable over Fox et al. in view of Durrenmatt, and further in view of Tansley.

Applicants respectfully traverse the rejection, and request it be withdrawn. The present rejection is simply based on the identification of individual components in the prior art, and there is no teaching, suggestion, or motivation to combine the references.

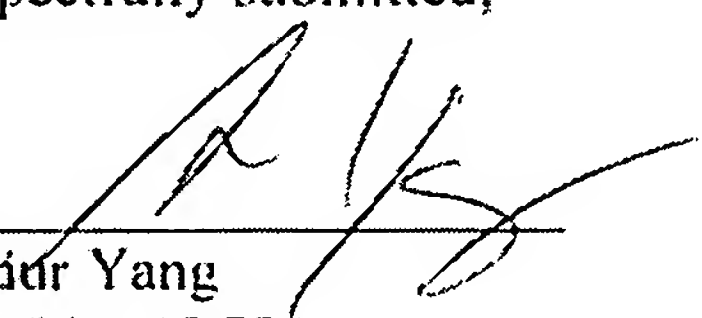
IV. Summary

Applicants have made a *bona fide* attempt to address all matters raised by the Examiner. Applicants respectfully submit that the application is now in condition for allowance, and therefore respectfully request that the outstanding rejections be withdrawn and that a Notice of Allowance be issued. If any remaining matters need to be resolved, Applicants respectfully request an interview with the Examiner prior to any official action being taken by the Office in response to these arguments and amendments in order to facilitate allowance of the pending claims.

The present response is being filed concurrently with a petition for extension of time, and it is believed no other fees are presently required. If a fee is required, please charge the same to Deposit Account 50-4255.

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Respectfully submitted,

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